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**MAY 15 2006**

**OFFICE OF PETITIONS**

In re Application of :  
Richard Alan McDonald : DECISION ON PETITION  
Application No. 10/684,851 :  
Filed: October 15, 2003 :  
Title: BREAKAWAY SUPPORT FOR :  
OVERHEAD LINES :

This is a decision on the "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)," filed August 29, 2005. Therein, applicant requests, in the alternative, that the application be revived pursuant to § 1.137(b) based on unintentional delay.

The petition under § 1.137(a) is **DISMISSED**.

The petition under § 1.137(b) is **DISMISSED** without consideration on the merits.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.137(a)" or "Renewed Petition under 37 C.F.R. § 1.137(b)," as appropriate. Extensions of time are permitted under § 1.136(a).

The above-identified application became abandoned for failure to timely reply to the non-final Office action mailed November 2, 2004. This Office action set a three (3) month shortened statutory period for reply, with extensions of time obtainable under § 1.136(a). A letter was filed in response on January 25,

2005; however, it was deemed not to be a bona fide reply. No extension of time having been obtained and no proper reply filed, the above-identified application became abandoned on February 3, 2005. A Notice of Abandonment was mailed on June 30, 2005.

Applicants timely filed the instant petition. Petitioner maintains that:

Applicant's abandonment was involuntary and unavoidable and would thus fall within the purview of 37 CFR §1.137(a). Applicant filed a timely reply and his actions confirm a bona-fide attempt to comply with the requirements of the USPTO and advance the prosecution of the matter. Applicant's reply was by no means cursory or lacking in detail or specificity. Although Applicant's reply may not have properly addressed the issues the Examiner raised under 35 U.S.C. §103(a) and/or have been in compliance with all formal requirements, applicant filed with a good faith belief that he had complied with all such requirements.

#### **Consideration under § 1.137(a)**

A grantable petition under § 1.137(a) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 C.F.R. §1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to §1.137(d). The instant petition lacks item(3).

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important

business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith, 671 F.2d at 538, 213 U.S.P.Q. at 982. Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

Petitioner's arguments have been considered, but have been determined not to meet their burden of showing that the delay was unavoidable within the meaning of § 1.137(a). Whether the applicant felt his response was a bona fide attempt to comply with all Office requirements is not controlling. It has been confirmed that the examiner reviewed the response and determined that it was not bona fide within the meaning of § 1.135(c)<sup>1</sup>. The examiner is the appropriate person to make that determination and the standard is not whether applicant believes the response is bona fide, or whether the response is cursory or lacking in detail or specificity. Further, there is no indication in the record that the examiner acted outside of 1.135(c) and petitioner's arguments that the response should have been considered bona fide are not well supported. (e.g., what is applicant's inadvertent omission). In any event, any request for review of the examiner's determination should have been made by petition to the Technology Center, along with a request to withdraw the holding of abandonment. In this instance, review of the determination of the examiner to any further extent on petition to revive is inappropriate.

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<sup>1</sup> § 1.135(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

Moreover, applicant's delay is more appropriately described as a failure to fully understand Office requirements, and thus, to have submitted an improper response. In this regard, it is well established that delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, however, does not constitute "unavoidable" delay. See Haines, 673 F. Supp. at 317, 5 USPQ2d at 1132; Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891). In addition, a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (A) the applicant's reliance upon oral advice from USPTO employees; or (B) the USPTO's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

In view thereof, it is concluded that petitioner has not made an adequate showing of unavoidable delay, and the petition cannot be granted under § 1.137(a).

#### **Consideration under §1.137(b)**

Petitioner requests, in the alternative, consideration under § 1.137(b) on the basis of unintentional delay. However, the petition does not include payment of the petition fee or authorization to charge any required fees to a Deposit Account.

The phrase "[o]n filing" in 35 U.S.C. 41(a)(7) means that the petition fee is required for the filing (and not merely the grant) of a petition under 37 CFR 1.137. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6 (1982), reprinted in 1982 U.S.C.C.A.N. 770 ("[t]he fees set forth in this section are due on filing the petition"). Therefore, the Office: (A) will not refund the petition fee required by 37 CFR 1.17(l) or 1.17(m), regardless of whether the petition under 37 CFR 1.137 is dismissed or denied; and (B) will not reach the merits of any petition under 37 CFR 1.137 lacking the requisite petition fee.

Accordingly, the petition under § 1.137(b) must be dismissed without consideration on the merits<sup>2</sup>.

Receipt of the power of attorney and change of correspondence address filed August 29, 2005 is acknowledged and made of record.

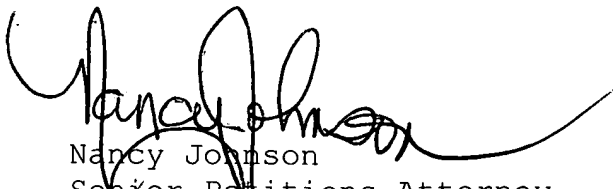
Further correspondence with respect to this decision should be addressed as follows:

By mail:           Mail Stop Petition  
                      Commissioner for Patents  
                      P.O. Box 1450  
                      Alexandria, VA 22313-1450

By fax:            (571) 273-8300  
                      ATTN: Office of Petitions

By hand:           Customer Service Window  
                      Randolph Building  
                      401 Dulany Street  
                      Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3219.



Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

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<sup>2</sup> To expedite reconsideration, petitioner may call the undersigned at 571-272-3219 to advise her when the fee payment has been made.